

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

APR 9 1999

In re	)	
	)	
Petitioner	)	Decision on Petition
	)	under 37 C.F.R. § 10.2(c)

MEMORANDUM AND ORDER

("Petitioner") requests review under 37 C.F.R. § 10.2(c) of a decision of the Director of Enrollment and Discipline ("Director"), entered August 7, 1998, denying in part his request, filed March 13, 1998, for a higher score on the morning section of the Registration Examination for Patent Attorneys and Agents ("examination"), held on August 27, 1997. The petition is denied.

SUMMARY

The Director's decision was on a request, under 37 C.F.R. § 10.7(c), for regrade of the morning section of the examination. Petitioner scored sixty-six points on this portion of the examination. The Director, in her August 7, 1998 decision, added two points to Petitioner's score, thereby raising it to sixty-eight, which is still two points short of the passing grade of seventy. This review of the Director's decision does not result in any additional points being awarded to Petitioner.

FACTS

Petitioner asks for review of the Director's final decision. In particular, Petitioner responds to the Director's comments concerning examination question 26. Question 26 concerns claims proposed for a reissue application. The text of the question follows:

26. V has invented a new composition for stabilizing and preserving blood products. On October 30, 1992, V filed a patent application in the PTO for his composition. The specification discloses that the composition includes: 10 to 40 percent active component, preferably 20 to 35 percent active component; 5 to 20 percent preservative, preferably 10 to 15 percent preservative; and 40 to 85 percent water, preferably 50 to 70 percent water. The patent issued on April 5, 1994, with the following single claim:

1. A blood preservative composition comprising 20 to 30 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.

On the evening of March 31, 1996, you receive a telephone call from V. In reviewing his patent, he has discovered an error in the patent that occurred without deceptive intent. He wants you to prepare a reissue application and make the following amendment to Claim 1 and add two claims.

- I. 1. A blood preservative composition comprising [20] 10 to [30] 40 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.
- II. 2. The blood preservative composition of claim 1, wherein the composition comprises 10 to 15 percent preservative.
- III. 3. A blood preservative composition comprising 20 to 35 percent active component; 10 to 15 percent preservative; and 50 to 70 percent water

You prepare and file the reissue application on April 1, 1996. Which of the above claims is/are proper in the reissue application?

- (A) I.
- (B) II.
- (C) I and II.
- (D) II and III.
- (E) I, II, and III.

The Director indicates that choice (E) is the most correct answer, that is, all three claims are proper. Petitioner chose (D). Director and Petitioner apparently agree that the broader and/or narrower ranges in the claims are not at issue. Instead, the grounds for petition concern claim format and an alleged problem of definiteness. In his request of March 13, 1998, Petitioner presented three arguments against choice (E) as the most correct answer:

- (1) claim 1 is improper because it fails to comply with 37 CFR 1.75(i);
- (2) claim 2 is improper because the term "composition" lacks antecedent basis; and

(3) claim 3 is improper because it fails to comply with the rule of MPEP 608.01(m).

Petitioner requested that choice (D) be deemed correct or, in the alternative, that question 26 be deleted.

The Director denied the request for points on question 26, but independently added two points for question 10, thus raising Petitioner's score to sixty-eight.

### DECISION

The "Directions" printed on the first page of the examination include the following statements:

Do not assume any additional facts not presented in the questions.

The most correct answer is the policy, practice, and procedure which must, shall, or **should** be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. (Emphasis added).

#### *Claim 1*

Petitioner asserted that claim 1 is not proper because it fails to use the format stated by Rule 1.75(i): "Where a claim sets forth a plurality of elements or steps, each element or step of the claim **should** be separated by a line indentation." (Emphasis added). 37 CFR 1.75(i).

Petitioner argues that claim 1 sets forth a composition comprising a plurality of elements but it fails to separate each element by a line indentation.

The Director's decision did not address Petitioner's argument.

Claim 1 does not have the line indentation format that claims "should" have according to 37 CFR 1.75(i). Nothing in the question suggests that 37 CFR 1.75(i) is not in force, and it

would be inconsistent with the examination Directions to make that assumption. Accordingly, claim 1 is improper.

### *Claim 2*

Petitioner argues that the phrase “the composition” in claim 2 lacks antecedent basis. Petitioner asserts that “a reasonable person with ordinary skill in the chemical arts would have trouble discerning what the word composition referred to in the claim,” and that the “active component” of claim 1 is also a composition. If Petitioner is correct, the claim is indefinite and fails to comply with 35 U.S.C. § 112, second paragraph.

The Director pointed out that a claim is not indefinite if the scope of the claim is reasonably ascertainable by those skilled in the art, citing MPEP 2173.05(e). The Director explained that “[i]n claim 2, it is clearly ascertainable that ‘the composition,’ which is preceded in claim 2 by ‘the blood preservative composition,’ refers only to the blood preservative composition.”

As the Director indicated, there is no reason to think persons of ordinary skill in the art would ignore the antecedent “blood preservative composition” in the same claim in favor of “active component” in another claim. The reasonable antecedent for “the composition” is “the blood preservative composition” identified by the Director in the same claim. Petitioner fails to explain how one of ordinary skill in the art could “have trouble discerning” the closest same word antecedent. Claim 2 is a proper claim.

### *Claim 3*

Petitioner asserted that claim 3 is improper because the terminal period was omitted, in violation of the “one sentence rule” in MPEP 608.01(m) (“Each claim begins with a capital letter

and ends with a period”). Petitioner points out that this “one sentence” rule was upheld by a court, citing Fressola v. Manbeck, 36 USPQ2d 1211, 1214-15 (D.D.C. 1995).

The Director found that “the omission of the period at the end of the claim does not prevent the claim from being a claim which is ‘proper in a reissue application’ under the given circumstances. The period may be later added by amendment.” However, the question gave no circumstances indicating that any MPEP rules were suspended and the Director does not identify any “given circumstances.” It is not apparent that there are any circumstances that reasonably indicate the “one sentence rule” does not apply. Petitioner argues that the Director’s observation, “[t]he period may be later added by amendment,” is an admission that the claim is improper.

Claim 3 is improper because it fails to comply with the “one sentence rule” of MPEP 608.01(m). A claim is not proper when an amendment is required to conform it to rule.

## CONCLUSION

Petitioner’s appeal brief filed with the Director on March 23, 1998, the Director’s decision of August 7, 1998, and Petitioner’s present petition have been reviewed.

Petitioner’s choice of D as the most correct answer to question 26 is incorrect because it includes the defective claim 3. The PTO originally indicated that E (all three claims are proper) is the most correct answer, but subsequently the omitted period typographical error was discovered in claim 3. Neither A (claim 1 is proper) nor C (claims 1 and 2 are proper) is the most correct answer because it could be argued that in a reissue, the plurality of elements in claim 1 should be set off by line indentations as stated in 37 CFR 1.75(i). See 37 CFR 1.176 (“the entire [reissue] application will be examined in the same manner as original applications”). In view of the Director’s finding that claim 2 is proper, if Petitioner had chosen either E (PTO’s original most

correct answer) or B (claim 2 is proper) points could have been awarded. However, because Petitioner chose D, Petitioner has not established that but for PTO action he would have answered correctly. No points will be awarded. Petitioner's exam score remains at sixty-eight, as determined by the Director in her decision entered August 7, 1998.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. TODD DICKINSON

Acting Assistant Secretary of Commerce and  
Acting Commissioner of Patents and Trademarks